

REMARKS

I. Introduction

Claims 15 to 31 are pending in the present application after addition of claims 30 and 31. Claims 15 and 29 have been amended, without prejudice. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants note with appreciation the indication of consideration of the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Rejection of Claims 15 to 18, 23, 28, and 29 Under 35 U.S.C. § 102(b)

Claims 15 to 18, 23, 28, and 29 were rejected under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 6,473,609 ("Schwartz"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as in the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). It is respectfully submitted that Schwartz does not teach each and every limitation of claims 15 to 18, 23, 28, and 29, as explained in detail below.

Amended claim 15 recites a method for transmitting messages between at least one main station and a terminal via a telecommunications network, including providing a matching device between the at least one main station and the

terminal and controlling a message exchange using the matching device, the message exchange being controlled in dependence upon at least one input from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station.* Support for this amendment may be found in the substitute specification, for example, on page 9, lines 7-12; page 9, lines 21-24; page 9, lines 27-31; and page 10, lines 23-32.

Amended claim 29 recites a matching device for transmitting messages between at least one main station and terminal via a telecommunications network, including at least one interface to the at least one main station, an interface to the terminal, a storage device configured to store at least one input from one of the terminal and the at least one main station for controlling a message exchange between the at least one main station and the terminal, and a control unit configured to control the message exchange as a function of the at least one input, *wherein the at least one input includes a message format request made by one of the terminal and the at least one main station.*

Schwartz discusses navigation of the Internet by two-way interactive communication mobile devices that are capable of wireless communication on the Internet via a link server with service providers or network servers. (Schwartz, Abstract.) According to Schwartz, a control engine in a link server is used to transmit data in a compact data format to an interface engine of a mobile device causing the mobile device to display contents of the markup language files on a display screen. (Schwartz, Abstract; Figure 9C; col. 2, lines 58 to 67; col. 4, lines 9 to 24; col. 9, lines 29 to 58.) The Schwartz system merely compresses markup language files into screen description data (SDD) files, which cause text of the markup language file contents to be displayed on the screens of mobile devices.

In contrast to Schwartz, the present invention may be used to convert, for example, "text to voice mail or text to fax." (Substitute Specification, page 10, lines 23 to 32.) Therefore, the matching device of the present invention will convert messages, e.g., "according to an input from a main station addressed by these messages, to a format requested by this main station." (Substitute Specification,

page 10, lines 23 to 32.) Therefore, the present invention is clearly different from merely compressing markup language files into SDD files as done in the Schwartz system.

None of the passages cited in the Office Action disclose, or even suggest, that "the message exchange is controlled in dependence upon at least one input from one of: i) the terminal, and ii) the at least one main station," as recited in claim 15. For example, col. 3, lines 38 to 55 of Schwartz merely state that according to one embodiment, the control engine is initiated when the mobile device establishes a communication session with the link server, after which the control device eventually converts a message to "a compact data file that can be easily transportable in the wireless network." It is noted that this passage does not provide any details or explanation of what controls the establishing of the communication session.

Similarly, col. 5, lines 47 to 61 of Schwartz merely state that a link server 114 functions as a bridge between landnet 100 and airnet 102, and that the link server may map or translate from one communication protocol in landnet to another in airnet or vice versa. Col. 7, lines 55 to 62 of Schwartz merely state that an account manager manages a number of user accounts for all the mobile devices and that each mobile device is assigned an ID number, such as a phone number or IP address. Col. 9, lines 29 to 41 of Schwartz merely state that since the mobile device typically does not have the necessary computing power to operate a browser in response to an HDML file, a message digester initially analyzes the file and a converter subsequently converts the file "into a set of screen commands that cause a mobile device, upon receiving the screen commands to display the contents in the HDML file according to the screen commands," which are typically expressed in SDD form.

Col. 10, lines 35 to 53 of Schwartz merely state that a mobile device may be identified by a device ID and include a client module that performs processing tasks, such as establishing a communication session with the line server, and requesting and receiving data from the from a carrier network. It is noted that

this passage of Schwartz does not include any details or explanation regarding the control of how the client module requests data or what the request includes.

Col. 11, lines 4 to 9 of Schwartz merely state that the mobile device communicates with a network server via a link server device, and that the network server may be any server on the Internet that provides accessible hypermedia information.

Col. 13, lines 25 to 38 of Schwartz merely state that when a user presses a predetermined key on the mobile device, the client module sends a request to the link server to display the next screen display, and that the control engine calls the converter to convert an HDML card to an SSD file. Col. 13, lines 64 to 66 merely state that each of the menus shown on the screen display is available on a service server or distributed on several server computers coupled to a network.

Col. 14, lines 10 to 58 of Schwartz merely state that the user may select from menu items displayed on the display screen using the keys, such as the number keys, which cause the client module in the mobile device to send a new request to the link server for a next screen display. This request may include a resource locator to another card cached in the link server or to a hyperlink of a URL in the card that has been converted to the SDD file currently being displayed.

For the foregoing reasons, Schwartz does not disclose, or even suggest, that the message exchange is controlled in dependence upon at least one input from one of: i) the terminal, and ii) the at least one main station, as recited in claim 15.

Independent of the above, it is also noted that amended claim 15 further recites that *the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station*. It is respectfully submitted that Schwartz also fail to disclose, or even suggest, this feature of amended claim 15.

Regarding claim 29, the Office Action cites several passages similar to those cited against claim 15 (some of the passages include or overlap those listed against claim 15), and it is respectfully submitted that, at least partly for the reasons stated in connection with claim 15, none of these passages of Schwartz disclose, or

even suggest, a storage device configured to store at least one input from one of the terminal and the at least one main station for controlling a message exchange between the at least one main station and the terminal and *a control unit configured to control the message exchange as a function of the at least one input, wherein the at least one input includes a format request made by one of the terminal and the at least one main station*, as recited in amended claim 29.

For the foregoing reasons, it is respectfully submitted that claims 15 and 29 are allowable over Schwartz. As for claims 16 to 18, 23 and 28, all of which ultimately depend from claim 15, and therefore include all of the features of claim 15, it is respectfully submitted that claims 16 to 18, 23 and 28 are allowable for at least the same reasons given above in connection with claim 15. It is therefore respectfully requested that this rejection of claims 15 to 18, 23, 28, and 29 be withdrawn.

III. Rejection of Claims 19, 20 and 22 Under 35 U.S.C. § 103(a)

Claims 19, 20 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz") in view of United States Patent No. 6,138,158 ("Boyle"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As recited above, Schwartz does not disclose, or even suggest, all of the features of claim 15, from which claims 19, 20 and 22 depend, e.g., controlling a message exchange using the matching device, *the message exchange being controlled in dependence upon at least one input* from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station.*

The Office Action merely cites Boyle for disclosing the following features: "if the terminal cannot be reached, storing the message until the matching device recognizes that the terminal can be reached"; "notifying the terminal of the availability of the message by the matching device, when the terminal cannot be reached"; and "segmenting, by the matching device as a function of the input from the terminal individual parts of a message, which includes a plurality of elements, and processing the message by the matching device." It is respectfully submitted that Boyle also does not disclose, or even suggest, the above features of claim 15 that are not disclosed by Schwartz. i.e., controlling a message exchange using the matching device, *the message exchange being controlled in dependence upon at least one input* from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station.*

For the foregoing reasons, it is respectfully submitted that claims 19, 20 and 22, all of which depend from claim 15, and therefore include all of the features of claim 15, are allowable over the combination of Schwartz and Boyle. It is therefore respectfully requested that this rejection of claims 19, 20 and 22 be withdrawn.

IV. Rejection of Claim 21 Under 35 U.S.C. § 103(a)

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz (A)") in view of United States

Patent No. 6,243,739 ("Schwartz (B)"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

As recited above, Schwartz (A) does not disclose, or even suggest, all of the features of claim 15, from which claim 21 depends, e.g., controlling a message exchange using the matching device, *the message exchange being controlled in dependence upon at least one input* from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station*.

The Office Action cites that Schwartz (B) for disclosing the following: "transmitting a plurality of messages, from different ones of the at least one main station, in a combined form to the terminal by the matching device." It is respectfully submitted that Schwartz (B) does not disclose, or even suggest, the above features of claim 15 that are not disclosed by Schwartz (A), i.e., controlling a message exchange using the matching device, *the message exchange being controlled in dependence upon at least one input* from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station*.

For the foregoing reasons, it is respectfully submitted that claim 21, which depends from claim 15, and therefore includes all of the features of claim 15, is allowable over the combination of Schwartz (A) and Schwartz (B). It is therefore respectfully requested that this rejection of claim 21 be withdrawn.

V. Rejection of Claims 24 to 27 Under 35 U.S.C. § 103(a)

Claims 24 to 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz") in view of United States Patent No. 6,560,640 ("Smethers"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

As recited above, Schwartz does not disclose, or even suggest, all of the features of claim 15, from which claims 19, 20 and 22 depend, e.g., controlling a

message exchange using the matching device, *the message exchange being controlled in dependence upon at least one input* from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station.*

The Office Action explicitly admits that Schwartz does not disclose the features of claims 24 to 27. Smethers is cited for purportedly teaching the features of claims 24 to 27. Therefore, the Office Action does not even allege that Smethers discloses, and it is respectfully submitted that Smethers does not disclose, or even suggest, the above features of claim 15 that are not disclosed by Schwartz, i.e., controlling a message exchange using the matching device, *the message exchange being controlled in dependence upon at least one input* from one of: i) the terminal, and ii) the at least one main station, *wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station.*

For the foregoing reasons, it is respectfully submitted that claims 24 to 27 which depend from claim 15, and therefore include all of the features of claim 15, are allowable over the combination of Schwartz and Smethers. It is therefore respectfully requested that this rejection of claims 24 to 27 be withdrawn.

VI. New Claims 30-31

Applicants respectfully submit that newly introduced claims 30-31 are clearly patentable over the prior art references. New claims 30-31 relate to transmitting messages between at least two main stations and a terminal via a telecommunications network, where a matching device is provided between the at least two main stations and the terminal to control the message exchange. None of the prior art references discloses this feature.

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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